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EXAMINER	
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ART UNIT	**PAPER NUMBER**
2617	

DATE MAILED: 05/19/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/010,687	TANAKA, YOSHIAKI	
	Examiner	Art Unit	
	Eliseo Ramos-Feliciano	2617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *06 February 2006*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-3,5-7,9-11,13-15,17,18,20,21,23,24,26 and 27* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-3,5-7,9-11,13-15,17,18,20,21,23,24,26 and 27* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Art Unit – Notice

1. The Art Unit location of your application in the USPTO has changed. To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to Art Unit 2617.

Claim Rejections - 35 USC § 112

2. Previous rejection under 35 USC 112, first paragraph, is withdrawn in view of Applicant's amendment filed February 6, 2006.

Claim Objections

3. **Claim 9** is objected to because of the following informalities: the recitation "cellular (d) phone" in lines 5-6 as amended, should be --cellular phone--. Correction is required.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. **Claims 1-3, 9-11, 17-18, and 23-24** are rejected under 35 U.S.C. 103(a) as being unpatentable over Valentine et al. (US Patent Number 6,011,973) in view of Steer (US Patent Number 6,643,517).

Regarding **claim 1**, Valentine et al. discloses a cellular phone (100) including a memory (150) and a controller (120); as depicted in Figure 1. A base station (180) in communication with the cellular phone (100). In detail, Valentine et al. discloses:

(a) a memory (150) storing first data (geographical locations where the cellular phone is prohibited from operating) indicative of predetermined sites (column 1, lines 58-59 and column 2, lines 45-53); and

(b) a controller (120) that compares a second data (current geographical location of the cellular phone / site of the cellular phone) to the first data (geographical locations where the cellular phone is prohibited from operating), and stops an operation of said cellular phone/modem (disables the transceiver 110), if said cellular phone is located at said predetermined sites indicated by said first data (column 1, lines 60-67 and column 2, lines 54-63).

- However, Valentine et al. fails to particularly disclose that the controller receives the second data (which second data indicates where said cellular phone is / site of the cellular phone) from a base station, as claimed by applicant.

Nevertheless, Valentine et al. teaches that the cellular phone (100) receives GPS transmissions indicative of longitude and latitude coordinates (second data that indicates where said cellular phone is / site of the cellular phone) from satellite (140); see column 2, lines 30-44.

Steer teaches to receive GPS transmissions via broadcast control channels from a base station (column 9, lines 36-43), and determining if the cellular phone is in a protected region (predetermined sites as claimed); see column 3, lines 51-58 of Steer. Thus, Steer teaches receiving GPS transmissions via a base station's broadcast control channel, instead of receiving the GPS transmissions directly from a satellite. Such teaching can be advantageous, for example, when the cellular phone is out of reach of the satellite's transmission beam, or out of the

satellite's range; allowing the cellular phone to still receive the GPS signal, that otherwise would not be able to receive.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify Valentine et al.'s invention as to receive GPS transmissions (information which indicates where said cellular phone is) via the base station's broadcast control channel, instead of receiving GPS transmissions directly from satellite 140, because this would allow the cellular phone to receive the GPS signal even when the cellular phone is out of reach of the satellite's transmission beam, or out of the satellite's range.

- However, Valentine et al. fails to specifically disclose **(c)** a modem which modulates signals to be transmitted from said cellular phone and demodulates signals received, and wherein said controller stops an operation of said modem, if said cellular phone is located at said predetermined sites indicated by said first data.

Nevertheless, Valentine et al. teaches that controller 120 stops an operation of said cellular phone by disabling the transceiver 110, if the cellular phone is located at the predetermined sites indicated by the first data (column 2, lines 60-63) as explained above.

Steer teaches disabling communications if the mobile radio unit is in a predetermined site (protected region); see column 6, lines 31-32 and 39-41 of Steer. The mobile unit can be a cellular phone, a laptop computer with mobile radio fax modem or the like; column 10, lines 44-50.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify Valentine et al.'s invention to extend its stop operation to a

modem as claimed, and as taught by Steer, because this would prevent a larger amount of users from annoying other people or equipment in restricted areas.

Regarding **claim 2**, Valentine et al. and Steer disclose everything claimed as applied above (see *claim 1*). In addition, Valentine et al. teaches that the predetermined sites are sites in which it is unpreferable to make a call through a cellular phone. Such as geographical locations where the cellular phone is prohibited from operating (column 2, lines 60-63); for example: airplane or airport runways (column 1, lines 38 and 43).

Regarding **claim 3**, Valentine et al. and Steer disclose everything claimed as applied above (see *claim 1*). In addition, Valentine et al. teaches that the controller downloads the first data (geographical locations where the cellular phone is prohibited from operating) into the memory (150) from an external database (190 - Figure 1) in cellular telephone network 170 via base station 180 (column 2, lines 63-67; column 3, lines 10-12).

Regarding **claim 9**, Valentine et al. discloses a cellular phone (100) including a memory (150) and a controller (120); as depicted in Figure 1. A base station (180) in communication with the cellular phone (100). In detail, Valentine et al. discloses:

(a) a memory (150) storing first data (geographical locations where the cellular phone is prohibited from operating) indicative of a first area in which predetermined sites are (column 1, lines 58-59 and column 2, lines 45-53); and

(b) a controller (120) that compares a second data (current geographical location of the cellular phone / site of the cellular phone) to the first data (geographical locations where the cellular phone is prohibited from operating), and stops an operation of said cellular phone

(disables the transceiver 110), if said cellular phone is located in said first area (column 1, lines 60-67 and column 2, lines 54-63).

- However, Valentine et al. fails to particularly disclose that the controller receives the second data (which second data indicates where said cellular phone is) from a base station, as claimed by applicant.

Nevertheless, Valentine et al. teaches that the cellular phone (100) receives GPS transmissions indicative of longitude and latitude coordinates (second data that indicates where said cellular phone is) from satellite (140); see column 2, lines 30-44.

Steer teaches to receive GPS transmissions via broadcast control channels from a base station (column 9, lines 36-43), and determining if the cellular phone is in a protected region (predetermined sites as claimed); see column 3, lines 51-58 of Steer. Thus, Steer teaches receiving GPS transmissions via a base station's broadcast control channel, instead of receiving the GPS transmissions directly from a satellite. Such teaching can be advantageous, for example, when the cellular phone is out of reach of the satellite's transmission beam, or out of the satellite's range; allowing the cellular phone to still receive the GPS signal, that otherwise would not be able to receive.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify Valentine et al.'s invention as to receive GPS transmissions (information which indicates where said cellular phone is) via the base station's broadcast control channel, instead of receiving GPS transmissions directly from satellite 140, because this would allow the cellular phone to receive the GPS signal even when the cellular phone is out of reach of the satellite's transmission beam, or out of the satellite's range.

• However, Valentine et al. fails to specifically disclose a modem which modulates signals to be transmitted from said cellular phone and demodulates signals received, and wherein said controller stops an operation of said modem, if said cellular phone is located at said predetermined sites indicated by said first data.

Nevertheless, Valentine et al. teaches that controller 120 stops an operation of said cellular phone by disabling the transceiver 110, if the cellular phone is located at the predetermined sites indicated by the first data (column 2, lines 60-63) as explained above.

Steer teaches disabling communications if the mobile radio unit is in a predetermined site (protected region); see column 6, lines 31-32 and 39-41 of Steer. The mobile unit can be a cellular phone, a laptop computer with mobile radio fax modem or the like; column 10, lines 44-50.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify Valentine et al.'s invention to extend its stop operation to a modem as claimed, and as taught by Steer, because this would prevent a larger amount of users from annoying other people or equipment in restricted areas.

• In addition, Valentine et al. and Steer, both disclose or depict that the area in which the predetermined sites (base stations) are centered roughly is circular in shape (see, for example, Figure 2 of Valentine et al. and Figure 1 of Steer). Moreover, the examiner contends that conventional base stations with omni directional capabilities have, in practice, roughly circular coverage areas.

However, Valentine et al. and Steer fail to specify the particular size of 50M as claimed.

Nevertheless, particular size and/or shape are obvious expedient as they are directed to engineering design choice matters. (See MPEP 2144.04). A change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify Valentine et al. and Steer's invention to achieve a circular shaped area having a radius of 50M because this would be the best engineering design choice, and because several decisions support the fact that change in size or shape are obvious expedient, see MPEP 2144.04.

Regarding **claim 10**, Valentine et al. and Steer disclose everything claimed as applied above (see *claim 9*). In addition, Valentine et al. teaches that the predetermined sites are sites in which it is unpreferable to make a call through a cellular phone. Such as geographical locations where the cellular phone is prohibited from operating (column 2, lines 60-63); for example: airplane or airport runways (column 1, lines 38 and 43).

Regarding **claim 11**, Valentine et al. and Steer disclose everything claimed as applied above (see *claim 9*). In addition, Valentine et al. teaches that the controller downloads the first data (geographical locations where the cellular phone is prohibited from operating) into the memory (150) from an external database (190 - Figure 1) in cellular telephone network 170 via base station 180 (column 2, lines 63-67; column 3, lines 10-12).

Regarding **claim 17**, Valentine et al. discloses a method of operating a cellular phone (100). A base station (180) in communication with the cellular phone (100), as depicted in Figure 1. The method including the steps of:

(a) storing first data (geographical locations where the cellular phone is prohibited from operating) indicative of predetermined sites (column 1, lines 58-59 and column 2, lines 45-53);

(b) receiving second data (GPS transmissions indicative of longitude and latitude coordinates) which second data indicates where said cellular phone is (current geographical location of the cellular phone / site of the cellular phone) (column 2, lines 30-44);

(c) comparing said second data to said first data (column 2, lines 54-56); and

(d) stopping an operation of said cellular phone/modem, if said cellular phone is located at said predetermined sites (column 2, lines 60-63).

- However, Valentine et al. fails to particularly disclose that the second data is received from a base station as claimed.

Nevertheless, Valentine et al. teaches that the cellular phone (100) receives the GPS transmissions (second data that indicates where said cellular phone is) from satellite (140); see column 2, lines 30-44.

Steer teaches to receive GPS transmissions via broadcast control channels from a base station (column 9, lines 36-43), and determining if the cellular phone is in a protected region (predetermined sites as claimed); see column 3, lines 51-58 of Steer. Thus, Steer teaches receiving GPS transmissions from a base station via a base station's broadcast control channel, instead of receiving the GPS transmissions directly from a satellite. Such teaching can be advantageous, for example, when the cellular phone is out of reach of the satellite's transmission beam, or out of the satellite's range; allowing the cellular phone to still receive the GPS signal, that otherwise would not be able to receive.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify Valentine et al.'s invention as to receive the GPS transmissions (information which indicates where said cellular phone is) from a base station via the base station's broadcast control channel, instead of receiving GPS transmissions directly from satellite 140, because this would allow the cellular phone to receive the GPS signal even when the cellular phone is out of reach of the satellite's transmission beam, or out of the satellite's range.

- However, Valentine et al. fails to specifically disclose that an operation of a modem of said cellular phone is stopped as claimed by applicant.

Nevertheless, Valentine et al. teaches that controller 120 stops an operation of said cellular phone by disabling the transceiver 110, if the cellular phone is located at the predetermined sites indicated by the first data (column 2, lines 60-63) as explained above.

Steer teaches disabling communications if the mobile radio unit is in a predetermined site (protected region); see column 6, lines 31-32 and 39-41 of Steer. The mobile unit can be a cellular phone, a laptop computer with mobile radio fax modem or the like; column 10, lines 44-50.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify Valentine et al.'s invention to extend its stop operation to a modem as claimed, and as taught by Steer, because this would prevent a larger amount of users from annoying other people or equipment in restricted areas.

Regarding **claim 18**, Valentine et al. and Steer disclose everything claimed as applied above (see *claim 17*). In addition, Valentine et al. teaches downloading said first data from an

external database. The controller downloads the first data (geographical locations where the cellular phone is prohibited from operating) into the memory (150) from an external database (190 - Figure 1) in cellular telephone network 170 via base station 180 (column 2, lines 63-67; column 3, lines 10-12).

Regarding **claim 23**, Valentine et al. discloses a method of operating a cellular phone (100). A base station (180) in communication with the cellular phone (100), as depicted in Figure 1. The method including the steps of:

(a) storing first data (geographical locations where the cellular phone is prohibited from operating) indicative of a first area in which predetermined sites are (column 1, lines 58-59 and column 2, lines 45-53);

(b) receiving second data (GPS transmissions indicative of longitude and latitude coordinates) which second data indicates where said cellular phone is (current geographical location of the cellular phone / site of the cellular phone) (column 2, lines 30-44);

(c) comparing said second data to said first data (column 2, lines 54-56); and

(d) stopping an operation of said cellular phone/modem, if said cellular phone is located in said first area (column 2, lines 60-63).

- However, Valentine et al. fails to particularly disclose that the second data is received from a base station as claimed.

Nevertheless, Valentine et al. teaches that the cellular phone (100) receives the GPS transmissions (second data that indicates where said cellular phone is / site of the cellular phone) from satellite (140); see column 2, lines 30-44.

Steer teaches to receive GPS transmissions via broadcast control channels from a base station (column 9, lines 36-43), and determining if the cellular phone is in a protected region (predetermined sites as claimed); see column 3, lines 51-58 of Steer. Thus, Steer teaches receiving GPS transmissions from a base station via a base station's broadcast control channel, instead of receiving the GPS transmissions directly from a satellite. Such teaching can be advantageous, for example, when the cellular phone is out of reach of the satellite's transmission beam, or out of the satellite's range; allowing the cellular phone to still receive the GPS signal, that otherwise would not be able to receive.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify Valentine et al.'s invention as to receive the GPS transmissions (information which indicates where said cellular phone is) from a base station via the base station's broadcast control channel, instead of receiving GPS transmissions directly from satellite 140, because this would allow the cellular phone to receive the GPS signal even when the cellular phone is out of reach of the satellite's transmission beam, or out of the satellite's range.

- However, Valentine et al. fails to specifically disclose that an operation of a modem of said cellular phone is stopped as claimed by applicant.

Nevertheless, Valentine et al. teaches that controller 120 stops an operation of said cellular phone by disabling the transceiver 110, if the cellular phone is located at the predetermined sites indicated by the first data (column 2, lines 60-63) as explained above.

Steer teaches disabling communications if the mobile radio unit is in a predetermined site (protected region); see column 6, lines 31-32 and 39-41 of Steer. The mobile unit can be a

cellular phone, a laptop computer with mobile radio fax modem or the like; column 10, lines 44-50.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify Valentine et al.'s invention to extend its stop operation to a modem as claimed, and as taught by Steer, because this would prevent a larger amount of users from annoying other people or equipment in restricted areas.

- In addition, Valentine et al. and Steer, both disclose or depict that the area in which the predetermined sites (base stations) are centered roughly is circular in shape (see, for example, Figure 2 of Valentine et al. and Figure 1 of Steer). Moreover, the examiner contends that conventional base stations with omni directional capabilities have, in practice, roughly circular coverage areas.

However, Valentine et al. and Steer fail to specify the particular size of 50M as claimed.

Nevertheless, particular size and/or shape are obvious expedient as they are directed to engineering design choice matters. (See MPEP 2144.04). A change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify Valentine et al. and Steer's invention to achieve a circular shaped area having a radius of 50M because this would be the best engineering design choice, and because several decisions support the fact that change in size or shape are obvious expedient, see MPEP 2144.04.

Regarding **claim 24**, Valentine et al. and Steer disclose everything claimed as applied above (see *claim 23*). In addition, Valentine et al. teaches downloading said first data from an external database. The controller downloads the first data (geographical locations where the cellular phone is prohibited from operating) into the memory (150) from an external database (190 - Figure 1) in cellular telephone network 170 via base station 180 (column 2, lines 63-67; column 3, lines 10-12).

6. **Claims 5-7, 13-15, 20-21, and 26-27** are rejected under 35 U.S.C. 103(a) as being unpatentable over Steer (US Patent Number 6,643,517).

Regarding **claim 5**, Steer discloses a cellular phone (10) including a controller (26); as depicted in Figure 2. A base station (6) for communications with the cellular phone (10); Figure 1. In detail, Steer discloses:

a controller (26) which uses first data (mobile radio's current location / site of the cellular phone) which indicates where said cellular phone is. The controller receives from a base station second data (protected region boundaries) which indicates a first site (12) within a service area (13) covered by said base station (6), compares the first data to said second data, and stops an operation of said cellular phone/modem, if said cellular phone is located at said first site (column 3, lines 40-54; column 4, lines 59-64, column 6, lines 20-26, 31-32, 39-41, column 8, lines 8-12). And

a modem (column 10, lines 44-50).

- However, Steer fails to particularly disclose receiving from the base station the first data which indicates where said cellular phone is / site of the cellular phone.

Nevertheless, Steer teaches that the mobile radio makes use of a suitable known location finding technique to determine its location (first data) (column 3, lines 49-50; column 6, lines 22-23). For example GPS (column 9, lines 36-43); wherein the GPS information (first data which indicates where said cellular phone is / site of the cellular phone) is received from a base station via broadcast control channels, for the advantage of improving the accuracy of the location determination process (see column 9, lines 42-43). Should be noted that the second data (protected region boundaries) is received from the base station via broadcast control channels also (column 9, lines 44-47; column 4, lines 61-64; column 5, lines 60-62).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to receive from the base station both the first data which indicates where said cellular phone is, and the second data which indicates a first site as claimed in a single embodiment, as suggested by the same Steer, for the advantage of improving the accuracy of the location determination process (see column 9, lines 42-43).

- However, Steer fails to specifically disclose that the controller stops an operation of a modem, if said cellular phone is located at said predetermined sites indicated by said first data, as claimed.

Nevertheless, Steer teaches disabling communications if the mobile radio unit is in a predetermined site (protected region); see column 6, lines 31-32 and 39-41 of Steer. The mobile unit can be a cellular phone, a laptop computer with mobile radio fax modem or the like; column 10, lines 44-50.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to extend Steer's stop operation to a modem as claimed, and as

suggested by the same Steer, because this would prevent a larger amount of users from annoying other people or equipment in restricted areas.

Regarding **claim 6**, Steer discloses everything claimed as applied above (see *claim 5*). In addition, Steer teaches that the first site is a site in which it is unpreferable to make a call through a cellular phone. For example: hospitals, aircraft, automobile, train, and other sensitive areas (column 1, lines 10, 22-28).

Regarding **claim 7**, Steer discloses everything claimed as applied above (see *claim 5*). In addition, Steer teaches that the controller downloads said second data thereinto from an external database (information server 8) (column 4, lines 64-66).

Regarding **claim 13**, Steer discloses a cellular phone (10) including a controller (26); as depicted in Figure 2. A base station (6) for communications with the cellular phone (10); Figure 1. In detail, Steer discloses:

a controller (26) which uses first data (mobile radio's current location / site of the cellular phone) which indicates where said cellular phone is. The controller receives from a base station second data (protected region boundaries) which indicates a first area (12) within a service area (13) covered by said base station (6), compares the first data to said second data, and stops an operation of said cellular phone, if said cellular phone is located at said first area (column 3, lines 40-54; column 4, lines 59-64, column 6, lines 20-26, 31-32, 39-41, column 8, lines 8-12). And

a modem (column 10, lines 44-50).

However, Steer fails to particularly disclose receiving from the base station the first data which indicates where said cellular phone is / site of the cellular phone.

Nevertheless, Steer teaches that the mobile radio makes use of a suitable known location finding technique to determine its location (first data) (column 3, lines 49-50; column 6, lines 22-23). For example GPS (column 9, lines 36-43); wherein the GPS information (first data which indicates where said cellular phone is) is received from a base station via broadcast control channels, for the advantage of improving the accuracy of the location determination process (see column 9, lines 42-43). Should be noted that the second data (protected region boundaries) is received from the base station via broadcast control channels also (column 9, lines 44-47; column 4, lines 61-64; column 5, lines 60-62).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to receive from the base station both the first data which indicates where said cellular phone is, and the second data which indicates a first area as claimed in a single embodiment, as suggested by the same Steer, for the advantage of improving the accuracy of the location determination process (see column 9, lines 42-43).

- However, Steer fails to specifically disclose that the controller stops an operation of a modem, if said cellular phone is located at said predetermined areas indicated by said first data, as claimed.

Nevertheless, Steer teaches disabling communications if the mobile radio unit is in a predetermined area (protected region); see column 6, lines 31-32 and 39-41 of Steer. The mobile unit can be a cellular phone, a laptop computer with mobile radio fax modem or the like; column 10, lines 44-50.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to extend Steer's stop operation to a modem as claimed, and as

suggested by the same Steer, because this would prevent a larger amount of users from annoying other people or equipment in restricted areas.

- In addition, Steer disclose or depict that the area in which the predetermined sites (base stations) are centered roughly is circular in shape (see, for example, Figure 1). Moreover, the examiner contends that conventional base stations with omni directional capabilities have, in practice, roughly circular coverage areas.

However, Steer fail to specify the particular size of 50M as claimed.

Nevertheless, particular size and/or shape are obvious expedient as they are directed to engineering design choice matters. (See MPEP 2144.04). A change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify Steer's invention to achieve a circular shaped area having a radius of 50M because this would be the best engineering design choice, and because several decisions support the fact that change in size or shape are obvious expedient, see MPEP 2144.04.

Regarding **claim 14**, Steer discloses everything claimed as applied above (see *claim 13*). In addition, Steer teaches that the first area is a area in which it is unpreferable to make a call through a cellular phone. For example: hospitals, aircraft, automobile, train, and other sensitive areas (column 1, lines 10, 22-28).

Regarding **claim 15**, Steer discloses everything claimed as applied above (see *claim 13*). In addition, Steer teaches that the controller downloads said second data thereinto from an external database (information server 8) (column 4, lines 64-66).

Regarding **claim 20**, Steer discloses a method of operating a cellular phone. A base station (6) in communication with the cellular phone (10), as depicted in Figure 1. The method including the steps of:

(a) receiving from a base station second data (protected region boundaries) which indicates a first site (12) within a service area (13) covered by said base station (6). The method also includes a first data (mobile radio's current location) which indicates where said cellular phone is. (column 3, lines 40-45, column 4, lines 59-64, column 6, lines 17-26)

(b) comparing said first data to said second data (column 3, lines 51-53; column 6, lines 24-26); and

(c) stopping an operation of said cellular phone/modem, if said cellular phone is located at said first site. (column 3, lines 55-58, column 6, lines 39-41).

- However, Steer fails to particularly disclose receiving from the base station the first data which indicates where said cellular phone is / site of the cellular phone.

Nevertheless, Steer teaches that the mobile radio makes use of a suitable known location finding technique to determine its location (first data) (column 3, lines 49-50; column 6, lines 22-23). For example GPS (column 9, lines 36-43); wherein the GPS information (first data which indicates where said cellular phone is) is received from a base station via broadcast control channels, for the advantage of improving the accuracy of the location determination process (see column 9, lines 42-43). Should be noted that the second data (protected region boundaries) is received from the base station via broadcast control channels also (column 9, lines 44-47; column 4, lines 61-64; column 5, lines 60-62).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to receive from the base station both the first data which indicates where said cellular phone is, and the second data which indicates a first site as claimed in a single embodiment, as suggested by the same Steer, for the advantage of improving the accuracy of the location determination process (see column 9, lines 42-43).

- However, Steer fails to specifically disclose that an operation of a modem of said cellular phone is stopped as claimed.

Nevertheless, Steer teaches disabling communications if the mobile radio unit is in a predetermined site (protected region); see column 6, lines 31-32 and 39-41 of Steer. The mobile unit can be a cellular phone, a laptop computer with mobile radio fax modem or the like; column 10, lines 44-50.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to extend Steer's stop operation to a modem as claimed, and as suggested by the same Steer, because this would prevent a larger amount of users from annoying other people or equipment in restricted areas.

Regarding **claim 21**, Steer discloses everything claimed as applied above (see *claim 20*). In addition, Steer teaches downloading said first data from an external database (information server 8) (column 4, lines 64-66).

Regarding **claim 26**, Steer discloses a method of operating a cellular phone. A base station (6) in communication with the cellular phone (10), as depicted in Figure 1. The method including the steps of:

(a) receiving from a base station second data (protected region boundaries) which indicates a first area (12) within a service area (13) covered by said base station (6). The method also includes a first data (mobile radio's current location / site of the cellular phone) which indicates where said cellular phone is. (column 3, lines 40-45, column 4, lines 59-64, column 6, lines 17-26)

(b) comparing said first data to said second data (column 3, lines 51-53; column 6, lines 24-26); and

(c) stopping an operation of said cellular phone/modem, if said cellular phone is located at said first area. (column 3, lines 55-58, column 6, lines 39-41).

However, Steer fails to particularly disclose receiving from the base station the first data which indicates where said cellular phone is / site of the cellular phone.

Nevertheless, Steer teaches that the mobile radio makes use of a suitable known location finding technique to determine its location (first data) (column 3, lines 49-50; column 6, lines 22-23). For example GPS (column 9, lines 36-43); wherein the GPS information (first data which indicates where said cellular phone is) is received from a base station via broadcast control channels, for the advantage of improving the accuracy of the location determination process (see column 9, lines 42-43). Should be noted that the second data (protected region boundaries) is received from the base station via broadcast control channels also (column 9, lines 44-47; column 4, lines 61-64; column 5, lines 60-62).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to receive from the base station both the first data which indicates where said cellular phone is, and the second data which indicates a first area as claimed in a single

embodiment, as suggested by the same Steer, for the advantage of improving the accuracy of the location determination process (see column 9, lines 42-43).

- However, Steer fails to specifically disclose that an operation of a modem of said cellular phone is stopped as claimed.

Nevertheless, Steer teaches disabling communications if the mobile radio unit is in a predetermined area (protected region); see column 6, lines 31-32 and 39-41 of Steer. The mobile unit can be a cellular phone, a laptop computer with mobile radio fax modem or the like; column 10, lines 44-50.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to extend Steer's stop operation to a modem as claimed, and as suggested by the same Steer, because this would prevent a larger amount of users from annoying other people or equipment in restricted areas.

- In addition, Valentine et al. and Steer, both disclose or depict that the area in which the predetermined sites (base stations) are centered roughly is circular in shape (see, for example, Figure 2 of Valentine et al. and Figure 1 of Steer). Moreover, the examiner contends that conventional base stations with omni directional capabilities have, in practice, roughly circular coverage areas.

However, Valentine et al. and Steer fail to specify the particular size of 50M as claimed.

Nevertheless, particular size and/or shape are obvious expedient as they are directed to engineering design choice matters. (See MPEP 2144.04). A change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify Valentine et al. and Steer's invention to achieve a circular shaped area having a radius of 50M because this would be the best engineering design choice, and because several decisions support the fact that change in size or shape are obvious expedient, see MPEP 2144.04.

Regarding **claim 27**, Steer discloses everything claimed as applied above (see ***claim 26***). In addition, Steer teaches downloading said first data from an external database (information server 8) (column 4, lines 64-66).

Response to Arguments

7. Applicant's arguments filed February 6, 2006 have been fully considered but they are not persuasive.

8. Applicant argues that Valentine nor Steer disclose a cellular phone having a modem that receives signals and converts between the phone and serving base station (see page 8, last paragraph of the response).

In response, the Examiner respectfully disagrees and draws attention to the fact that Valentine et al. teaches that controller 120 stops an operation of said cellular phone by disabling the transceiver 110, if the cellular phone is located at the predetermined sites indicated by the first data (column 2, lines 60-63) as explained above. Steer teaches disabling communications if the mobile radio unit is in a predetermined site (protected region); see column 6, lines 31-32 and 39-41 of Steer. The mobile unit can be a cellular phone, a laptop computer with mobile radio fax modem or the like; column 10, lines 44-50. The combination meets the claimed language.

9. In response to applicant's argument that argued invention requires fewer components or minimizing components (see page 9, top partial paragraph and second full paragraph of the response), the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., applicant's invention requires fewer components as no conversion hardware or software independent from the modem is necessary, or minimizing components; see page 9, top partial paragraph and second full paragraph of the response) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

10. Rest of Applicant's arguments are directed to the newly added limitations. These arguments have been considered but are, therefore, moot in view of the new ground(s) of rejection.

Conclusion

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

12. Any inquiry concerning this communication from the examiner should be directed to Eliseo Ramos-Feliciano whose telephone number is 571-272-7925. The examiner can normally be reached from 8:00 a.m. to 5:30 p.m. on 5-4/9 1st Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marsha Banks-Harold, can be reached on (571) 272-7905. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

ELISEO RAMOS-FELICIANO
PRIMARY EXAMINER

ERF/erf
May 12, 2006